



Docket No.: 1293.1050

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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In re the Application of:

Ki-young KIM, et al.

Serial No. 09/179,405

Group Art Unit: 2642

Confirmation No.

Filed: October 27, 1998

Examiner: W. DEANE, JR.

For: TELEPHONE NUMBER SEARCHING SYSTEM SUPPORTING AUTOMATIC
TELEPHONE CONNECTION AND METHOD THEREFOR

APPELLANT'S REPLY UNDER 37 C.F.R. § 1.193

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Assistant Commissioner
for Patents
Washington, D.C. 20231

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Technology Center 2600

This is in response to the Examiner's Answer mailed July 31, 2002 and having a date for reply of September 30, 2002.

Grouping of Claims

In the Appellant's Brief, the following claims were grouped to stand or fall together: (A) claims 1-7; (B) 8-13; and (C) 14-16 and 18, 19. In the Examiner's answer, the Examiner does not agree with the grouping to the claims and asserts that "[the] claims, therefore should stand or fall together with claim 1." The Examiner states: "Appellant basically states that "claim 8 is deemed to be patentable at least for reasons set forth above regarding claim 1"

Claims 1-7 are apparatus claims and claims 8-13 are method claims. The fact that similar arguments may apply does dictate that the method claims should stand or fall with the apparatus claims.

The Prior Art of Record:

The Examiner's listing of the Prior Art of Record includes only the U.S. Patents which the Examiner listed in a PTO 1449 attached to the Office Action April 25, 2001. The Examiner's listing does not include the references listed in an Information Disclosure Statement (IDS) filed September 12, 2000. The Examiner acknowledged that the references included in the IDS of September 12, 2000 were considered on April 11, 2001, by initialing and signing the PTO 1449 included in the September 12, 2000 IDS and returning a copy of the initialed and signed PTO 1449 with the Office Action mailed April 25, 2001.

The references listed in the IDS of September 12, 2000 are as follows:

Document	Date	Country	
9-81447	3/28/97	Japan	abstract only
10-98467	4/14/98	Japan	abstract only
10-322465	12/4/98	Japan	abstract only
7-297924	11/10/95	Japan	abstract only
10-164256	6/19/98	Japan	abstract only
10-336346	12/18/98	Japan	abstract only
10-336349	12/18/98	Japan	abstract only
11-122589	4/30/99	Japan	abstract only

A non-patent document reference, NTT Technology Journal, May 1, 1997, Vol. 9, No. 5, pp.72-76 was also included in the September 12, 2000 IDS. In the initialed and signed copy of the PTO 1449, the Examiner correctly noted that a document 10-98467 was duplicated in the PTO 1449 listing. The duplication has been eliminated from the above listing.

Rebuttal to Examiner's Response to Argument

The Examiner asserts that the Applicants seem to argue two things with respect to the plug-in. The Examiner asserts that Applicants argue that "the plug-in in Wood et al. does not set up a communication channel through a telephone independent of a web server and the information terminal." Second, the Examiner asserts that Applicants have argued that "there is no plug-in at all in the Wood et al. reference." Regarding these assertions, in the Appeal Brief, Applicants, in commenting on the Examiner's assertion that it would have been obvious to substitute one known plug-in for another, argued:

"In this regard, the Examiner's conclusion appears unsupported since the Wood et al. device has no telephone plug-in 'connected with the information terminal' as claimed in claim 1. Thus, there is no telephone plug-in in Wood et al. for which another telephone plug-in could be substituted."

What Applicants were pointing out is that it is the claim language which must be considered. Claim 1 recites, "a telephone plug-in, connected with said phone and said information terminal, to automatically dial one telephone number selected by a user among the at least one displayed telephone number to set up a communication channel through said phone independent of said web server and said information terminal."

In the present invention, the telephone number is dialed by "a telephone plug-in, connected with said phone and said information terminal". In Wood et al. the telephone number is dialed under the control of the web facility 22 and does not use "a telephone plug-in, connected with said phone and said information terminal, to automatically dial one telephone number selected by a user among the at least one displayed telephone number to set up a communication channel through said phone independent of said web server and said information terminal," as claimed in claim 1.

Admittedly, on a macro view, similar ultimate results are achieved with the apparatus disclosed in Wood et al. and with the apparatus claimed in the present invention. That is, a communication channel between two telephones is set up. However, just because similar results are achieved, does not mean that embodiments of the apparatus for achieving the results are also the same.

Clearly, Wood et al. does not disclose "a telephone plug-in connected with said phone and said information terminal" as claimed in claim 1. Neither does Wood et al. disclose a method including "operating a telephone plug-in to dial the selected one telephone number automatically and independently of said web server," as claimed in claim 8. In Wood et al., the web facility 22 communicates from the web facility to a telephone switch via a switch-computer interface and the telephone switch establishes the connection in response to the telephone connection message.

The Examiner argues "it would have been more than obvious to use a 'plug-in' function as taught by Shachar et al. in the Personal computer of Wood et al." However, a person of ordinary skill in the art would not have been motivated to add the "plug-in" of Shachar et al. to the apparatus of Wood et al. in order to dial the searched for number since Wood et al. already achieve a connection between the phone and the searched for telephone number according to a different apparatus and a different method.

At page 5 of the Examiner's Answer, the Examiner asserts that "Hundreds of plug-ins (software components) have been available for sale for many years." This assertion appears to have been made without benefit of any support in the prior art of record.

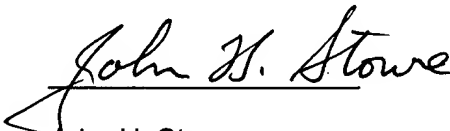
Summary

For the reasons set forth above and in the Appeal Brief and the previous Office Action responses filed in this application, it is submitted that claims 1-16, 18 and 19 patentably distinguish over U.S. Patent 6,091,808 to Wood et al. in view of U.S. Patent 5,764,736 to Shachar et al.

Thus, it is respectfully submitted that the Examiner's final rejection of the claims is without support and, therefore, erroneous. Accordingly, the Board of Patent Appeals and Interferences is respectfully urged to so find and to reverse the Examiner's final rejection.

If any fees are required in connection with the filing of this Reply Brief, please charge same to our Deposit Account No. 19-3935. Respectfully submitted,

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